

37 5/19/99
Suppl. Response
RESPONSE UNDER 37 C.F.R. §1.116
EXPEDITED PROCEDURE
ART UNIT 1652

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Richard M. Lawn, Gordon A. Vehar, and Karen L. Wion

FAX RECEIVED

Serial No: 08/444,934

Art Unit: 1652

MAY 12 1999

GROUP 1600

Filed: May 22, 1995

For: *METHODS AND DEOXYRIBONUCLEIC ACID FOR THE PREPARATION
OF TISSUE FACTOR PROTEIN*ATT: KAREN CARLSON
Assistant Commissioner of Patents
Washington, D.C. 20231

RESPONSE UNDER 37 C.F.R. § 1.116

Sir:

In further response to the Office Action mailed January 14, 1999, and the telephone conference today, regarding support for the reference to soluble tissue factor from which the transmembrane domain, alone or in combination with the cytoplasmic domain, enclosed is a copy of the Opposition by Diagnostica Stago (an English translation; the original was filed in French) which was filed in the corresponding European Patent. Relevant sections have been marked. In particular, it is apparent that this third party opposer not only thought that the claim

MSM101CONTC
21121/10

Serial No: 08/444,934
Filed: May 22, 1995
RESPONSE UNDER 37 C.F.R. § 1.116

to tissue factor not including the transmembrane domain meant not including either the transmembrane OR the cytoplasmic domain, but also that it was obvious to make such a variant of tissue factor, and cited art in support thereof.

The Examiner's attention is also drawn to the specification (in addition to those portions cited earlier) which states at page 7, lines 11-17:

... "novel tissue factor protein derivatives, in particular derivatives lacking the signal sequence and the hydrophobic portion of the protein near the C-terminal end of the protein comprising the amino acid sequence which constitutes the tissue factor protein transmembrane or membrane binding domain."

It is certainly understood by those in the patent area that the term "comprising" means "including", not limited to. This should be effective to overcome the rejection under 35 U.S.C. § 112, in combination with Dr. Konigsberg's expert declaration, mailed July 17, 1996, which stated that:

"those of skill in the arts of proteins, cloning and expression, and tissue factor at that time would have understood the descriptions of deletion of the transmembrane region of tissue factor to include tissue factor proteins from which the entire C-terminal region, including the transmembrane and cytoplasmic regions, had been deleted. This is so because the deletion of the transmembrane region as described in the specification would have been viewed and understood as an indication that the extracellular domain could be used separately from both the transmembrane region and the cytoplasmic region".

MSM101CONTC
21121/10

Serial No: 08/444,934
Filed: May 22, 1995
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In summary, the subject matter of the claims is fully described and allowance of claims 20, 21, 23, 24, 25, 27, 28, 29, and 31-41, is earnestly solicited.

Respectfully submitted,



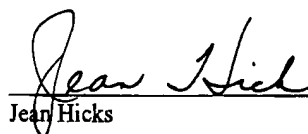
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Date: May 12, 1999

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I hereby certify that this Response to Office Action, along with any paper referred to as being attached or enclosed, is being facsimile transmitted to the Assistant Commissioner for Patents, Washington, D.C. 20231.


Jean Hicks

Date: May 12, 1999